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	First Named Inventor	Osamu Yamashita	
	Art Unit	2617	
	Examiner Name	Shedrick, Charles Terrel	
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Appellants' Reply Brief on Appeal
S/N: 10/714,672

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Osamu Yamashita, et al.

Serial No.: 10/714,672

Group Art Unit: 2617

Filed: November 18, 2003

Examiner: Shedrick, Charles Terrell

For: **CELLULAR NETWORK ACQUISITION METHOD AND APPARATUS**

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL

Sir:

Appellants have appealed the rejection of claims 1-5, 7-14, and 16-20 in the Office Action mailed on February 14, 2006. A Notice of Appeal was timely filed on May 15, 2006. This Reply Brief responds (in Section VII) to points of the Examiner's Answer mailed on November 30, 2006.

I. REAL PARTY IN INTEREST

The real party in interest is NEC Corporation, assignee of 100% interest of the above-referenced patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or Assignee which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Docket WN-2622 (GOT.081)

III. STATUS OF CLAIMS

Claims 1-5, 7-14, and 16-20, all of the claims presently pending in the application, stand rejected on prior art grounds. Claims 6 and 15 are canceled.

Claims 1, 2, 4, 8-11, 13, 14, 17, and 18 stand rejected under 35 USC §103(a) as unpatentable over WO 02/37889 to Ramesh et al., further in view of US Patent Publication 2004/0058650 to Palenius et al. Claims 3 and 12 stand rejected under 35 USC §103(a) as unpatentable over Ramesh/Palenius, further in view of US Patent Publication 2004/0203745 to Cooper. Claims 7, 16, 19, and 20 stand rejected under 35 USC §103(a) as unpatentable over Ramesh/Palenius, further in view of US Patent Publication 2004/0224684 to Dorsey et al.

The rejections are being appealed for all pending claims.

IV. STATUS OF AMENDMENTS

A Request for Reconsideration and Withdrawal of Final Rejection under 37 CFR §1.116 was filed on April 4, 2006. In the Advisory Action mailed April 21, 2006, the Examiner indicated that the rejections were maintained. The claims in the Appendix reflect the version of the claims of the Amendment Under 37 CFR §1.111 as filed on November 16, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

As explained at line 28 of page 4 through line 16 on page 5, Appellants have recognized that the 3GPP specification requirement for five measurements for each frequency within the frequency band be obtained within 3 seconds as being equally spaced does not necessarily mean that each of the large number of measurements be equally spaced from each other. The present invention uses the realization that only the measurements conducted on the same frequency need to be equally spaced (lines 8-13 on page 5).

Moreover, as explained at lines 12-18 of page 3, this technique allows a second band of frequencies to be searched, either within the same RAT (radio technology) or in another RAT, as well as second-stage search operations.

Therefore, Appellants' invention, as disclosed and claimed in, for example, independent claim 1 (independent claim 10 has corresponding language), is directed to Docket WN-2622 (GOT.081)

a method of determining a most suitable cell during network acquisition for a cellular communications device, based on a characteristic of signals received from a plurality of cells, the signals from each cell being provided over a band of frequencies.

A series of measurements of the characteristic for each frequency of a first frequency band is taken, so as to obtain an average measurement value of the characteristic for each frequency of the first frequency band, wherein the series of measurements on the first frequency band are equally spaced in time, with equal time intervals therebetween.

During the time intervals between measurements for the first frequency band, a series of measurements of the characteristic for each frequency of a second frequency band is taken (lines 5-9 on page 6).

Thus, as shown in the Figure, during the four equal-time intervals 12,14,16,18 shown on the horizontal axis over which a first frequency 1 is to be measured five times A,B,C,D,E, the present inventors have recognized that all remaining frequencies (e.g., 2 through n, shown in the vertical axis) of the RAT under evaluation can be rapidly and sequentially measured immediately after each respective measurement A,B,C,D,E of the first frequency 1.

As further explained at lines 17-24 on page 5 (and reflected in the independent claims), there are exemplarily (at least) two bands of frequencies represented in the n = 546 frequencies shown in the vertical axis: the EGSM 900 band contains 172 frequencies, and the GSM 1800 band contains 374 frequencies. Alternatively, as mentioned above, the second band might be for a second RAT.

Thus, the two independent claims being appealed are described in the text and figures, as follows. It is noted that only independent claim 1 is represented below, since independent claim 10 is a device claim that corresponds to the method claim of claim 1.

Independent claim 1: A method of determining a most suitable cell (lines 1-3 of page 1) during network acquisition for a cellular communications device, based on a characteristic of signals received from a plurality of cells (lines 25-28 of page 1), the signals from each cell being provided over a band of frequencies, said method comprising:

taking a series of measurements (e.g., A through E in figure, also lines 17-18 on Docket WN-2622 (GOT.081))

page 5) of said characteristic for each frequency of a first frequency band (item 10 in figure includes a first band, also line 19 of page 5), so as to obtain an average measurement value (line 16 of page 5) of said characteristic for each frequency of said first frequency band, wherein the series of measurements on said first frequency band are equally spaced in time, with equal time intervals therebetween (see figure, also line 28 of page 1 through line 3 of page 2 and lines 11-13 of page 5); and

during the time intervals between measurements for said first frequency band, taking a series of measurements of said characteristic for each frequency of a second frequency band (lines 19-24 of page 5).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants present various issues for review by the Board of Patent Appeals and Interferences, as follows:

ISSUE 1: Whether the plain meaning of the independent claims is satisfied by the primary reference Ramesh, even if all secondary references currently of record are combined;

ISSUE 2: Whether primary reference Ramesh can be modified in the manner urged in the rejection currently of record without improperly changing its principle of operation;

ISSUE 3: Whether secondary references Palenius and Cooper are properly combinable with primary reference Ramesh unless they are considered analogous art or reasonably related to the problem of the present invention; and

ISSUE 4: Whether the rejection based on secondary reference Dorsey can be maintained when its U.S. filing date precludes it as prior art against the present application because of the foreign priority date of the present application.

VII. ARGUMENTS (APPELLANTS' RESPONSE TO EXAMINER'S ANSWER)

Upon review of the Examiner's Answer, mailed on November 20, 2006, Appellants submit the following comments additional to the comments of the Appeal Brief originally filed on July 17, 2006, and re-submitted on September 2, 2006, as revised in response to the Notification of Non-Compliant Appeal Brief mailed on August 4, 2006. Appellants maintain the arguments in the Brief and do not repeat them herein.

First, Appellants bring to the Board's attention that secondary reference Palenius, et al. (US Patent Publication 2004/0058650) fails to overcome the deficiency in primary reference Ramesh (WO 02/37889) identified on page 4 of the Examiner's Answer (e.g., "... *Ramesh does not specifically teach during the time intervals between measurements for said [first] frequency band, taking a series of measurements of said characteristic for each frequency of a second frequency band*").

The final claim limitation of, for example, independent claim 1 is:

"... during the time intervals between measurements for said first frequency band, taking a series of measurements of said characteristics for each frequency of a second frequency band."

The Examiner points to paragraphs [0014] and [0033] of Palenius. However, Appellants submit that, to one having ordinary skill in the art, these paragraphs merely describe making measurements "... on a second frequency."

That is, Appellants submit that secondary reference Palenius makes no suggestion that these second frequencies are in a second frequency band, as required by the plain meaning of the claim language.

Therefore, Appellants submit that, even if Ramesh were to be modified by Palenius, the combination would still fail to satisfy the plain meaning of the claim language.

Independent claim 10 even defines two distinct units respectively used for the two bands of frequency. The rejection simply ignores this language in claim 10 directed to the second unit and, therefore, clearly fails to present a *prima facie* rejection for claim 10.

Second, relative to dependent claims 5 and 14, there is no suggestion in line 25 of page 9 through line 2 of page 10 or lines 1-5 of page 11 of Ramesh of the precise time interval described in the claim.

Third, relative to the Examiner's discussion beginning on the bottom of page 12 under the section entitled "Priority", Appellants submit the following response.

On page 14, the Examiner declares: *"The Examiner respectfully submits the evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons after numerous notices why the evidence was not presented earlier giving the examiner time to consider if the document contains the claimed subject matter. 37 CFR 1.116(e)."*

In response, Appellants submit that 37 CFR §1.116(e) reads:

"(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented."

Appellants submit that there are actually two entries in the Evidence Appendix of the Appeal Brief, as follows:

(1) a copy of Appellants' documentation that is already of record that clearly indicates that Appellants did not submit DE 10314 694.6, as the Examiner alleges. This point was clearly described in Appellants' submittal dated April 4, 2006, wherein Appellants submitted this same evidence and explained on page 2 of the Appellants' response that Appellants had actually submitted UK 0226980, not DE 10314 694.6.

(2) a copy of UK 0226980, as obtained by Appellants' representative from the Internet access of the UK Patent Office.

Appellants submit that the first evidence attachment must be presented to the Board as a matter of right, since this evidence is already of record.

Relative to the second evidence attachment, Appellants submit that this uncertified copy of the UK priority document was intended as a courtesy to the Examiner and the USPTO to preclude the necessity of finding the Appellants' original Docket WN-2622 (GOT.081)

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submission. It is clear from this uncertified copy that the priority document for the present invention is not DE 10314 694.6, since, as correctly noted by the Examiner, this German document "does not match" the description or field of the present invention.

Appellants submit that it is very clear that the USPTO has simply misplaced Appellants' submission of the priority document, as evidenced by the first evidence attachment.

If the Examiner does not wish to forward this non-certified copy of UK 0226980, attached as the second entry of the evidence appendix as a courtesy, then Appellants respectfully submit that the USPTO has the duty to find the original submission and place it in the correct file prior to forwarding the record to the Board. Appellants' representative has already conducted a search of the USPTO database, as available to the public, to attempt to locate the US Application that relies upon priority document DE 10314 694.6. This search was not successful, since this application has not yet issued and is, therefore, information that is not yet available to the public. Appellants believe that the USPTO will have ready access to this information and respectfully requests that either the Examiner or the Board retrieve the correct priority document originally submitted by Appellants, as evidenced by the first evidence attachment, if the Examiner does not wish to forward the courtesy copy.

As mentioned in Appellants' Brief, the correct priority document UK 0226980 is readily available from the UK Patent Office via the Internet, and this priority document clearly reflects the contents of the present application disclosure, so that there is no reasonable doubt that Appellants actually submitted DE 10314 694.6, as alleged by the Examiner.

Furthermore, Appellants submit that the relevant governing procedure is actually defined in 35 U.S.C. § 119(b):

"(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.”

As Appellants have maintained throughout prosecution and, as evidenced by the first attachment to the evidence appendix, the certified copy of the correct priority document was indeed provided to the USPTO, and the USPTO clearly erroneously placed this copy in the wrong file, presumably during the scanning process. The statute does not place the burden on applicants to keep on providing certified copies of the priority document until the USPTO gets at least one of these certified copies into the correct file.

Therefore, again, if the Examiner refuses to forward the courtesy copy of the UK priority document, as downloaded from the UK Patent Office, Appellants respectfully request that the USPTO properly do its job by locating the original submission and placing it in the correct file prior to forwarding the record to the Board.

Alternatively, Appellants submit that the Board might want to consider that the “... showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented” is clearly present in a case in which the USPTO refuses to locate the original document, even though Appellants have clearly explained during prosecution that the correct document was indeed submitted by Appellant and has been misplaced within the USPTO.

Whether the second attachment to the evidence appendix is forwarded to the Board is somewhat irrelevant, when the facts readily available to the public clearly indicate that the correct priority document is UK 0226980, not DE 10314 694.6, completely consistent with Appellants' statements during prosecution and as evidenced by the first attachment in the evidence appendix. Appellants clearly had no reason

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whatsoever to submit document DE 10314 694.6, as the Examiner alleges. Nor does Appellants have the means to locate the missing original document or the burden to continue providing certified copies of the priority document until at least one certified copy ends up in the correct file at the USPTO.

Accordingly, Appellants submit that the facts, even if the Examiner refuses to forward the courtesy copy of the second entry of the evidence appendix, clearly require that the Board give the legal priority date to the present application in its analysis of the qualification as prior art of the various references cited by the Examiner.

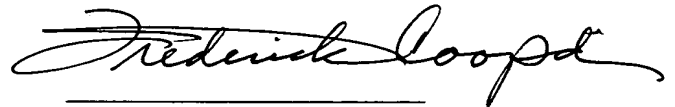
VIII. CONCLUSION

In view of the foregoing, Appellants submit that claims 1-5, 7-14, and 16-20, all the claims presently pending in the application, are clearly patentably distinct from the prior art of record and in condition for allowance. Thus, the Board is respectfully requested to remove all rejections of claims 1-5, 7-14, and 16-20.

Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Attorney's Deposit Account number 50-0481.

Respectfully submitted,

Dated: 1/30/07



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